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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,048

01/28/2002

Juerg Muentener

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22428

7590

09/15/2003

FOLEY AND LARDNER
SUITE 500
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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,048

Applicant(s)

MUENTENER, JUERG

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings were received on 6/24/2002. These drawings are disapproved by the Examiner for the following reasons.

3. The drawings are objected to because the use of the reference "5' " in figure 3 is improper. The Examiner is of opinion that the mentioned reference should be changed to -5—(see figures 1 and 2). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See the specification in pages 7-8. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The features recited in the claims which are not shown/illustrated in at least one figure are as follow: First, the feature relating to the objective and the eyepiece as

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recited in each of claims 1 and 12 (lines 2-3 of each claim); Second, the feature relating to the reflection of a portion of light out of the beam path to the eyepiece as recited in each claims 1 and 12 (lines 6-7 of claim 1 and lines 7-8 of claim 12) (Note: Applicant should note that figure 1 shown the reflection of light out of the beam path to other device, not the eyepiece); Third, the feature relating to the coupling of various microscope accessories on one end of carrier facing away from the beam splitter as recited in each of claims 3 and 14; Fourth, the feature relating to the use of a plane-parallel plate on the carrier when there is not any beam-splitter on the carrier as recited in each of claims 6 and 18; Fifth, the feature relating to the further optical components on the carrier as recited in each of claims 9 and 21; and Sixth, the feature relating to the coding formed on the carrier as recited in each of claims 10 and 23.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities: a) The Summary of the Invention is objected to because it is too long and contains numerous details of the invention. Applicant should provide a brief summary of the invention and

move other description to the section of "DETAILED DESCRIPTION OF THE INVENTION"; b) Page 8: lines 11 and 14, "3" should be changed to – 3' --. See same page on line 9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 16/14/12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim is rejected under 35 USC 112, first paragraph because the specification does not teach the use of a carrier supporting a beam splitter on one end and various microscope accessories on the end facing away from the beam splitter wherein both the beam splitter and the different microscope accessories are inserted into the light path(s).

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a) Claim 1 is rejected under 35 USC 112, second paragraph because the feature thereof "a basic body... eyepiece" (lines 2-3) is unclear. It is unclear about the structural relationships among the basic body, the microscope objective and the eyepiece as recited in the mentioned feature.

The claim is also rejected under 35 USC 112, second paragraph by the recitation thereof "wherein the beam splitter...the eyepiece" (lines 6-7). The mentioned recitation is misdescriptive of the invention as shown in the figure(s). Applicant is respectfully invited the manner in which light is transmitted and reflected by the beam splitter with respect to the beam path defined by the objective and the eyepiece as shown in the figure(s). In other words, the portion of light (L1 or R1) is reflected from the beam splitter to other device which is not the eyepiece and the portion of light (L2 or R2) is transmitted by the beam splitter to the eyepiece.

b) Claim 2 is rejected under 35 USC 112, second paragraph because it is unclear about the manner in which the carrier is fitted into the recess so that the beam splitter is aligned relative to the beam path without the need for further alignment as recited in the claim.

c) Claim 12 is rejected for the similar reasons as set forth in element a) above.

d) Claim 13 is rejected for the similar reason as set forth in element b) above.

e) Claim 20 is rejected under 35 USC 112, second paragraph because the feature "splitters" (line 2) lacks a proper antecedent basis. Applicant should note that claim 20/19/1 recites only one splitter.

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- f) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

Double Patenting

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Claim 19/1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7/1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

14. Claim 20/19/1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 8/7/1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16. Claims 1-3, 7-11 and 19-20, as best as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa et al (U.S. Patent No. 6,219,180).

Hasegawa et al disclose an optical unit switching apparatus for a microscope having an illuminating system. The device as described in columns 4-7 and shown in figures 5-12 comprises a microscope having a basic body (03), an objective lens system (04,05), an eyepiece lens system (02) wherein the objective and the eyepiece systems define a beam path (13), a container (30) supporting a plurality of beam splitters (19a-19d) and their guiding/switching mechanism (31,38,43) wherein the container can be inserted into the microscope and selectively placed a particular beam splitter on the optical axis (13) (see column 4). While Hasegawa et al do not clearly state that the basic body (03) has a recess; however, the basis body inherently has a recess for receiving the container and has sufficient space for allowing the insertion and the movement of

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the container. The switching apparatus provided by Hasegawa et al also comprises the following features: 1) At the other end of the carrier (31), there are a plurality of microscope accessories in the form of display members (29a-29d) (see column 4) and the carrier (31) supports a plurality of beam splitters having different optical properties in wavelengths transmitted and/or reflected (see columns 4 and 6); 2) each of the beam splitter is a combinations of two triangular prisms (see column 6); 3) the selective beam splitter is aligned with the optical axis (see column 5); 4) display elements (29a-29d) act as a coding system which transmits to a user information about the type of beam splitter which is present on the optical axis at a particular time so that the user can perform any adaptation or operation by using the microscope with the selective beam splitter. It is noted that the use is considered as a control system because the present claims 10-11 fails to provide any specific limitations of the control unit recited in the claim(s)..

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 5, 12-14, 17 and 21-24, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al (U.S. Patent No. 5,303,082, submitted by applicant) in view of Hasegawa et al (U.S. Patent No. 6,219,180).

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Obuchi et al disclose a stereomicroscope having an illuminating system and an observation system which has first and second beam paths. In each of the beam path, there is at least one beam splitter located in the light path for reflecting a portion of light to other accessory of the microscope and for transmitting the remaining portion of light to an eyepiece lens system. It is noted that Obuchi et al do not disclose that the beam splitter is mounted on a carrier which is able to releasably insert into the recess formed on the basic body of the microscope. It is also noted that while Obuchi et al do not explicitly state that their microscope is a surgical microscope; however, one skilled in the art will recognize that the microscope provided by Obuchi et al is able to use in a surgical performance. Regard to the use of a carrier for supporting a plurality of beam splitters having different optical properties missing from the art of Obuchi et al, it is noted that such use of a carrier supporting plural different beam splitters in a microscope is known to one skilled in the art as can be seen in the microscope provided by Hasegawa et al. Hasegawa et al disclose an optical unit switching apparatus for a microscope having an illuminating system. The device as described in columns 4-7 and shown in figures 5-12 comprises a microscope having a basic body (03), an objective lens system (04,05), an eyepiece lens system (02) wherein the objective and the eyepiece systems define a beam path (13), a container (30) supporting a plurality of beam splitters (19a-19d) and their guiding/switching mechanism (31,38,43) wherein the container can be inserted into the microscope and selectively placed a particular beam splitter on the optical axis (13) (see

column 4). While Hasegawa et al do not clearly state that the basic body (03) has a recess; however, the basis body inherently has a recess for receiving the container and has sufficient space for allowing the insertion and the movement of the container. The switching apparatus provided by Hasegawa et al also comprises the following features: 1) At the other end of the carrier (31), there are a plurality of microscope accessories in the form of display members (29a-29d) (see column 4) and the carrier (31) supports a plurality of beam splitters having different optical properties in wavelengths transmitted and/or reflected (see columns 4 and 6); 2) each of the beam splitter is a combinations of two triangular prisms (see column 6); 3) the selective beam splitter is aligned with the optical axis (see column 5); 4) display elements (29a-29d) act as a coding system which transmits to a user information about the type of beam splitter which is present on the optical axis at a particular time so that the user can perform any adaptation or operation by using the microscope with the selective beam splitter. It is noted that the use is considered as a control system because the present claims 10-11 fails to provide any specific limitations of the control unit recited in the claim(s). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope provided by Obuchi et al by using a carrier supporting a plurality of different beam splitters and their switching mechanism as suggested by Hasegawa et al for the purpose of switching a particular beam splitter into the optical axis for a particular application which reduces the time installation and cost.

Allowable Subject Matter

19. Claims 4/3/1 and 15/14/12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

20. The following is an examiner's statement of reasons for allowance:

The device as claimed in each of claims 4/3/1 and 15/14/12 is patentable with respect to the applied art by the limitation relating to the rotation of the carrier by an angle of 180 degrees about an axis perpendicular to the beam path so that the beam splitter is used for reflecting in and reflecting out. While the use of a beam splitter rotating by an angle of 180 degrees for such a purpose is known to one skilled in the art as can be seen in the apparatus provided by Aziz et al (see column 7 and figure 6); however, there is not any modification for combining the teaching provided by Aziz et al with the teaching provided by either Hasegawa et al (U.S. Patent No. 6,219,180) or Koyama et al (U.S. Patent No. 6,226,118) based on the differences in structures.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are cited as of interest in that each

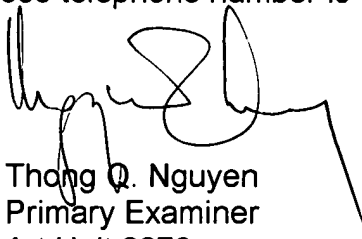
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discloses a mechanism for supporting a plurality of optical elements and for selectively inserting a particular optical element into the light path.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
